

REMARKS

Reconsideration of the pending application is respectfully requested on the basis of the following particulars.

1. Finality of rejection

The applicant notes that page 1 of the Office action indicates that the Office action is final. The applicant's representative was unable to find any basis for making this action final in view of the reopening of prosecution from appeal. The representative consulted with the examiner on this matter, and indeed it was determined that the finality of the rejection was in error. Accordingly, the outstanding action is treated as a non-final rejection.

2. In the claims

Claim 24 is currently amended to recite that the first and second types of floor panels have different decors, and the set of individual panels are packaged in a single box. Support for the amendment with regard to different decors is found at least in the first and second paragraphs on page 14, and Figs. 5 and 6, and the amendment with regard to the box is found in the specification on page 8, first full paragraph, and Figs. 8 and 9.

The claims dependent from claim 24 are amended in view of the amendment to claim 24.

New claim 37 is added and finds support from the subject matter of claim 24 and claim 35. Claim 37 describes the inventive subject matter of the pending application as a method for packaging a set of floor panels.

Entry of the amendment to the previously pending claims and the submission of new claims is respectfully requested in the next Office communication.

3. Rejection of claims 24-36 under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent 3,641,730 (*Meckstroth*) in view of U.S. patent 6,863,768 (*Haffner*), U.S. patent 4,479,333 (*Hendrich*) and U.S. patent 6,256,952 (*Fahy*)

Reconsideration of this rejection is respectfully requested in view of the remarks submitted in the appeal brief submitted on August 20, 2007 incorporated herein by reference, the amendment to claim 24 from which the remaining claims depend, and the following additional and revised observations.

Despite the reopening of prosecution in this application, the rejection of claim 24 remains intact from the last Office action dated May 25, 2007. Upon a review of the current grounds for rejecting claim 24, the applicant stands by the prior arguments submitted in the appeal brief. The appeal brief arguments are still pertinent in view of the amendment to claim 24.

The amendment to claim 24 requires that the first and second types of floor panels have different decors. As depicted in Figs. 5 and 6 of the specification, this limitation indicates that the first and second types of floor panels will have a decor different from one another, which are at least due in part to the fact that they have different lengths and therefore cannot have the same decor.

Haffner, which is relied upon in the action for its decorative layer, does not convey the understanding to the skilled person to provide first and second types of floor panels having both different lengths and different decors.

Hendrich, which is relied upon in the action for the teaching of packaging panels for transportation, does not suggest to the skilled person the concept of floor panels of different lengths being packaged in a single box. Contrary to the assertion in the action that the skilled person would have appreciated packaging panels in “any convenient, efficient and low cost manner,” it is submitted that the skilled person would not understand packaging panels in a single box from *Hendrich* because *Hendrich* describes large-scale, interconnected (via hinged joints) structural panels which are particularly used as building modules (i.e., floor panels – not floor covering, side wall panels, and roof elements).

The panels of *Hendrich* are of a magnitude that the skilled person would readily recognize as being unsuited for packaging in a single box. Particularly, at least in reference to claim 35, the skilled person would not understand from *Hendrich* to provide floor panels having different lengths in that a first type of floor panel having a first length spans the length of the box, and the second and third type of floor panels (of different lengths) are arranged in the box at the same level and have second and third lengths which combine to span the entire length of the box (i.e., combined length the same as the first length).

While *Meckstroth* teaches that the structural panels may be provided in different widths or lengths, there is no suggestion by *Meckstroth* of taking the unobvious step of the pending claims to provide a set of floor panels having different lengths in a single box, as required by the amended claims. *Meckstroth* merely indicates that the panels may be prefabricated in different widths or lengths (col. 2, lines 50-55). There is no indication that these differently sized panels may be provided in a set (for forming one and the same floor covering) that includes panels of different dimensions.

In observing *Meckstroth*, it is readily apparent that the passage relied upon in the rejection (col. 2, lines 50-55) merely conveys that panels of different dimensions may be produced according to different applications such as “depending on whether the panels are intended for use as floor panels, wall panels, ceiling panels, or roof panels.” From this passage, without the benefit of the pending application, one skilled in the art would understand that depending on the particular application, the structural panels will have a certain dimension. For example, the structural roof panels may have a certain width and length, whereas the structural floor panels may have a certain width that is different from the roof panels.

Contrary to the assertion in the rejection, claim 24 clearly requires that the differently sized panels be provided in a set for forming one and the same flooring covering, and that the set of panels is packaged in a single box. It is submitted that *Meckstroth* clearly does not advise the skilled artisan of doing anything more than merely providing differently sized structural panels, and does not motivate the skilled

artisan to take the unobvious step of packaging the set of panels in a single box, as mandated by the amended claims.

The rejection also appears to continue to indicate that *Fahy* teaches providing floor panels of different sizes in a set. The appellant respectfully disagrees. While *Fahy* discusses the fact that the floor panels may be in different sizes (col. 1, lines 40-46; col. 5, lines 23-34), there is nothing in *Fahy* that would motivate one skilled in the art to provide such differently sized floor panels in a set for one and the same floor covering. Instead, *Fahy* just discusses the fact that floor panels have different sizes and the problems associated with the differently sized panel. *Fahy* does not describe the unobvious step of a providing a set of floor panels in a single box.

Thus, *Fahy* does not make up for the shortcomings of *Meckstroth*, and hence none of the references cited in the rejection instruct the skilled artisan to take the unobvious step of providing a set of panels for forming one and the same floor covering with differently sized panels in a single box.

In the view of these observations and those in the appeal brief, it is submitted that the proposed combination of *Meckstroth*, *Haffner*, *Hendrich* and *Fahy* fails to render the pending claims *prima facie* obvious since these references taken as a whole and in combination fail to teach every feature required by the pending claims. Moreover, there is no suggestion among these references or rationale articulated in the rejection which shows that one skilled in the art would be motivated to make the proposed combination to devise the set of packaged decorative floor panels according to the pending claims.

Accordingly, withdrawal of the rejection is respectfully requested.

4. Rejection of claims 24-36 under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent 3,641,730 (*Meckstroth*) in view of U.S. patent 6,863,768 (*Haffner*), U.S. patent 4,479,333 (*Hendrich*) and U.S. patent 6,256,952 (*Fahy*) and further in view of U.S. patent 5,403,055 (*Allison*)

Reconsideration of this rejection is respectfully requested in view of the preceding remarks on the rejection based on the combination of *Meckstroth*, *Haffner*,

Hendrich and *Fahy* of claim 24 from which claim 35 depends, and following observations on *Allison*.

In the action, *Allison* is relied upon to show that it was known to arrange building panels at a same vertical level in a package so as to span the entire length of the package. However, it will be noted that claim 35 requires more than such a proposition, as articulated in the action. Instead, claim 35 particularly requires that a panel of first type of panel spans the length of a box, and that a floor panel of each a second and third type of panels, which are described as having different lengths, are arranged in the box at a same level so as to combine to span the entire length of the box.

Nowhere in *Allison* is there any particular understanding of packaging panels of the types described and required by claim 35. Indeed, while the action refers to Figs. 4, 6 and 7 of *Allison* as teaching the basic limitations of claim 35, these figures appear to only describe panels, logs and roof trusses of a single length, and not of multiple lengths. Because the panels, logs and roof trusses described by *Allison* are of a single length, there is no understanding of arranging panels of different second and third lengths along a same level in a box.

Thus, *Allison* fails to disclose or suggest every limitation for which it is included in the combination with *Meckstroth*, *Haffner*, *Hendrich* and *Fahy*. Likewise, *Meckstroth*, *Haffner*, *Hendrich* and *Fahy* fail to make up for the shortcomings of *Allison*.

Accordingly, the skilled person would not understand from the combination of *Meckstroth*, *Haffner*, *Hendrich*, *Fahy* and *Allison* the limitations of claim 35. Withdrawal of this rejection is respectfully requested.

It will be pointed out that the new method claim 37 requires the particular step of arranging floor panels of second and third lengths along a same level in the same manner as claim 35. Thus, at least for the reasons provided above, claim 37 is patentable over the combination of *Meckstroth*, *Haffner*, *Hendrich*, *Fahy* and *Allison*.

5. Conclusion

As a result of the amendment to the claims and the foregoing remarks, it is respectfully submitted that the application is in condition for allowance. Accordingly, it is respectfully requested that every pending claim in the present application be allowed and the application be passed to issue.

If any issues remain that may be resolved by a telephone or facsimile communication with the applicants' attorney, the examiner is invited to contact the undersigned at the numbers shown below.

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Respectfully submitted,

A handwritten signature in black ink, appearing to read "Justin J. Cassell", written over a horizontal line.

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